

## REMARKS

This Amendment is responsive to the Office Action of May 17, 2002. Claims 1 and 18 have been amended. Claims 26-39 have been added. Claims 1-39 are pending in this case. Reconsideration is respectfully requested.

## GENERALLY

Applicant would initially like to thank the Examiner for the careful review of the disclosure. Applicant has amended the claims in view of the Examiner's helpful written comments. If it appears that any further changes are desired, Applicant invites the Examiner to telephone the undersigned agent.

## CLAIM REJECTIONS – CLAIMS 1 and 18 – §102

Claims 1 and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by **Newman** (US 5,837,913). Each of claims 1 and 18 is independent.

Applicant has amended each of Claims 1 and 18 to clarify that the pick can be translationally moved from a first position to a second position on the meatus of the user's thumb.

**Newman** has a flat pick that is not intended for use on the thumb of a user. Furthermore, **Newman** does not teach or suggest translational movement of the pick along the thumb or finger. Therefore, claims 1 and 18 are considered to define over the reference to **Newman**.

Furthermore, it would not have been obvious to move the pick of **Newman** along the meatus of the thumb in light of any teachings of **Newman**. To provide first and



second translationally spaced positions has the specific advantage of selectively providing the pick in an easily retrievable retracted first position or in a second position of use. Therefore, providing the distinct translational positions is not considered to be merely a matter of design choice.

These changes to claims 1 and 18 find support in the Specification at page 8, lines 25-29 and throughout the figures. Therefore, Claims 1 and 18 are considered to be allowable over **Newman**. Claims 2-9 and 19-22 are considered to be allowable as depending from allowable base Claims 1 and 18 and for further patentable features that may be recognized by the Examiner.

#### CLAIM REJECTIONS – CLAIMS 2-7 and 19-22 – §103

Claims 2-7 and 19-22 were rejected under 35 U.S.C. §103 as being unpatentable over **Newman** (US 5,837,913) in view of **Mapson** (US 5,981,857).

The Examiner apparently relies upon **Mapson** to show that it would have been obvious to provide the first and second positions. However, the reference to **Mapson** does not teach first and second positions for a given sleeve and pick combination. Rather **Mapson** teaches a specific position for a specific sleeve. Furthermore, there is no motivation in **Mapson** to apply the position of the sleeve shown in Figure 2 of **Mapson** to the sleeve of **Newman**. In fact, doing so appears that it would interfere with the user's ability to play the instrument. That is, if the device of **Newman** were to be placed at the tip of a playing finger as taught by **Mapson**, then the device of **Newman** would get in the way of proper playing.

The Examiner also relies upon **Mapson** for teaching angular positioning and the tip being exterior of the sleeve. However, there is no reason taught or suggested in either of the references to combine **Mapson** with **Newman** to provide these features. The Examiner's statement of motivation appears to have some grammatical errors and does not make sense. The Examiner's stated reason for combining appears to omit providing some needed advantage taught by **Mapson** for the device of **Newman**.

Therefore, there is no reason to combine the position shown for the finger pick in Figure 2 of **Mapson** to the sleeve and pick of **Newman**. Furthermore, there is no reason to provide the teaching of orienting the pick of **Newman** at different angles as taught by **Mapson**. As such, Claims 2-7 and 19-22 are considered to be allowable over **Newman** in view of **Mapson**.

On the other hand, the amendments to Claims 1 and 18 are considered to define over the base reference to **Newman**. **Mapson** is not considered to provide the deficiencies of the **Newman** in order to meet the limitations now recited in Claims 1 and 18. Therefore, Claims 2-7 and 19-22 are considered to be patentable as depending from base Claims 1 and 18 as set forth above.

### **CLAIM REJECTIONS – CLAIMS 8 and 9 – §103**

Claims 8 and 9 were rejected under 35 U.S.C. §103 as being unpatentable over **Newman** (US 5,837,913) in view of **Gallagher** (US 3,992,975).

The Examiner relies upon **Gallagher** to provide a pad. The Examiner's statement of motivation is that "[i]t would have been obvious ... to modify the pick as taught by **Newman** with the pad as taught by **Gallagher** in order to provide a pick that

conforms to the contours of the player's fingertip." However, **Newman's** sleeve is disposed on a portion of the finger closest to the hand and not at the "tip". Therefore the pad would not aid in providing a pick that conforms to the contours of the player's fingertips. Furthermore, the element 24 cited by the Examiner as being the "pad" of **Gallagher** adds nothing to the apparatus of **Newman** since it is merely part of a hook and loop fastening means of the type already utilized by **Newman**.

On the other hand, claims 8 and 9 are considered to be allowable by virtue of their dependence on allowable independent Claims 1 and 18 and for further patentable features, which may be recognized by the Examiner.

#### **NEW CLAIMS -- 26-39**

The new claims 26-30 correspond to claims 18-22 and include the same matter. Claims 26-30 are considered to be allowable as depending directly or indirectly from allowable base claim 10, and for further features therein as may be recognized by the Examiner. Claims 31-39 correspond to claims 1-9 and include the same matter. Claims 31-39 are considered to be allowable as depending directly or indirectly from allowable base claim 10, and for further features therein as may be recognized by the Examiner.

#### **SUMMARY**

Based on the above amendments and accompanying remarks, Applicant respectfully submits that all pending claims are in condition for allowance and earnestly solicits a notice thereof. Applicant encourages the Examiner to telephone the

undersigned agent if it appears that a telephone conference would facilitate allowance of the application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on

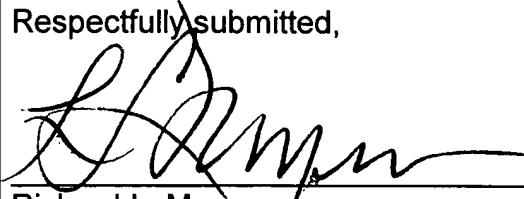
September 17, 2002

by Cortney Gollands

Courtney Gollands  
Signature

September 17, 2002

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**Version With Markings To Show Changes Made**

**In the Claims:**

The claims have been amended as follows:

1. A pick apparatus adapted for use by a user having a thumb with a meatus, to strum/pick strings of a musical instrument, comprising:

a pick adapted to be held by the user and to be moved in a contacting and strumming relationship with the strings of the musical instrument;

a thumb sleeve adapted for disposition on the thumb of the user;

attachment means including a first structure carried by the sleeve and a second structure carried by the pick, the attachment means being adapted for releasably attaching the pick to the sleeve; and

the attached pick being moveable by the fingers of the user between a first position and a second position translationally spaced from the first position on the meatus of the thumb.

18. A pick combination adapted for use in strumming/picking the strings of a musical instrument, comprising:

a sleeve having a tubular configuration and extending longitudinally between a proximal opening and a distal opening, the sleeve having an exterior surface, and an interior surface defining an interior region of the sleeve;

a pick having a tip and being disposed relative to the sleeve with the tip extending exteriorly of the sleeve; and

attachment means for removably coupling the pick to the sleeve in a first position on the sleeve; and

the pick further having a second position on the sleeve, the second position being translationally spaced from the first position so that the pick may be moved in and out of a position of use by the user.

New Claims have been added as follows:

26. The pick combination recited in Claim 10 further comprising:

a sleeve having a tubular configuration and extending longitudinally between a proximal opening and a distal opening, the sleeve having an exterior surface, and an interior surface defining an interior region of the sleeve;

the pick having a tip and being disposed relative to the sleeve with the tip extending exteriorly of the sleeve; and

attachment means for removably coupling the pick to the sleeve.

27. The pick combination recited in Claim 26, wherein the attachment means and the pick are disposed exteriorly of the sleeve.

28. The pick combination recited in Claim 26, wherein the attachment means and the pick are disposed in the interior region of the sleeve with the tip of the pick projecting exteriorly of the sleeve.

29. The pick combination recited in Claim 28, wherein the tip of the pick extends through the distal opening of the sleeve.

30. The pick combination recited in Claim 28, wherein:

portions of the sleeve define a lateral hole extending through the sleeve; and

the tip of the pick extends exteriorly of the sleeve through the lateral hole.

31. The pick combination as recited in claim 10, and adapted for use by a user having a thumb with a meatus, further comprising:

the pick adapted to be held by the user and to be moved in a contacting and strumming relationship with the strings of the musical instrument;

a thumb sleeve adapted for disposition on the thumb of the user;

attachment means including a first structure carried by the sleeve and a second structure carried by the pick, the attachment means being adapted for releasably attaching the pick to the sleeve; and

the attached pick being moveable by the fingers of the user between a first position and a second position spaced from the first position on the meatus of the thumb.

32. The pick combination recited in Claim 31, wherein:

the thumb is disposed generally in a plane and has a tip and a longitudinal configuration; and

the first position is laterally spaced from the second position on the meatus of the thumb.

33. The pick combination recited in Claim 31, wherein in the thumb is disposed generally in a plane and has a tip and a longitudinal configuration; and

the first position is longitudinally spaced from the second position on the meatus of the thumb.

34. The pick combination recited in Claim 32, wherein:

the pick in the first position has a first angle relative to the plane of the thumb; and

the pick in the second position has a second angle different than the first angle relative to the plane of the thumb.

35. The pick combination recited in Claim 33, wherein:

the pick in the first position is disposed in a proximal relationship to the tip of the thumb; and

the pick in the second position is disposed in a spaced relationship with the tip of the thumb.

36. The pick combination recited in Claim 32, wherein:

the first position is an extended position; and

the second position is a retracted position.

37. The pick combination recited in Claim 31, further comprising:

means for biasing the pick to the second position.

38. The pick combination recited in Claim 31, wherein the pick has a generally planar configuration and the combination further comprises:

a pad disposed on the side of the pick opposite the attachment means; and

the pad having a first surface generally parallel to the plane of the pick and a second surface generally non-parallel to the plane of the pick.

39. The pick combination recited in Claim 38, wherein the pad is tapered.